

DOCKET NO: 270161US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
SHIGERU SUZUKI, ET AL. : EXAMINER: O'HERN, B. T.
SERIAL NO: 10/530,480 :
FILED: OCTOBER 6, 2005 : GROUP ART UNIT: 1794
FOR: HEAT-SHRINKABLE FILM :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated March 20, 2008 (Answer).

The statement of the Grounds of Rejection (Answer at 3-13) is essentially identical to the statement in the Rejection appealed from, which has already been responded to in the Appeal Brief. The following is in reply to the "Response to Argument" (Answer at 13-16).

In response to Applicants' argument that Matsui et al does not disclose or suggest the presently-recited limitation that the block copolymer of component (A) of Claim 1 have a microphase separation structure comprising a soft phase and a hard phase, the Examiner merely points to the disclosure in Matsui et al at column 8, line 64 to column 10, line 51 (Answer at 13), against which Applicants have already rebutted in the Appeal Brief at page 6.

In response to Applicants' argument that Matsui et al neither discloses nor suggests the presence of a styrene type polymer having a syndiotactic structure, the Examiner simply finds that in the Appeal Brief at page 7, Applicants take "the opposite position that styrene

type polymers include syndiotactic styrene type polymers. Thus, styrene type polymers clearly include syndiotactic styrene type polymers” (Answer at 13-14).

In reply, Applicants have never argued that the genus of styrene type polymers does not include, in effect, syndiotactic styrene type polymers. Rather, Applicants have pointed out the significant differences between syndiotactic styrene type polymers and garden-variety styrene type polymers and argued that Matsui et al neither discloses nor suggests the presence of a syndiotactic styrene type polymer.

In response to Applicants’ argument that it would not have been obvious to substitute, in effect, the syndiotactic polystyrene of Lind et al, presumably as a styrene polymer in Matsui et al, the Examiner repeats his previous finding, already responded to in the Appeal Brief, that Lind et al discloses the benefits of a narrow molecular weight distribution which provides for narrow crystalline and melting point ranges, and then finds that these properties “are clearly important for the rigors that heat shrinkable multilayered films undergo during use” (Answer at 14).

In reply, the Examiner continues to mischaracterize the disclosure in Lind et al which, as Applicants have pointed out in the Appeal Brief, does not disclose any particular advantage of syndiotactic polystyrene over any other polystyrene. Nor does the Examiner present any evidence that a narrow molecular weight distribution which provides for narrow crystalline and melting point ranges, are clearly important for the rigors that heat shrinkable multilayered films undergo during use.

The Examiner finds that Applicants have argued that if Matsui et al “used syndiotactic polystyrene then the result would not be the same as Applicant claims”, that Applicants have “not presented any analysis or evidence to support said conclusion,” and that it seems as though Applicants are “concluding that its own invention is incredible” since Matsui et al’s structure with syndiotactic polystyrene “is the same as Appellants” (Answer at 14).

In reply, Applicants have argued that even if a syndiotactic polystyrene were used in Matsui et al, the result would still not be the presently-claimed invention. The basis for this argument is that Matsui et al neither discloses nor suggests, as discussed above, presently-recited component (A).

Regarding Applicants' argument for separate patentability of Claim 9, the Examiner responds "that since the structures have the same composition they also have the same melting point and melting energy" (Answer at 14-15).

In reply, even if the prior art suggested the presence of a styrene type polymer having a syndiotactic structure, the Board can take official notice that the presently-recited crystalline melting point range and crystalline melting energy of Claim 9 is not inherent in all styrene type polymers having a syndiotactic structure.

Similarly, for the separate patentability of Claim 10, while the Examiner finds "that since the structures have the same composition they also have the same crystallinity and crystallization temperature" (Answer at 15), even if the applied prior art suggested the heat shrinkable film of Claim 1, the Board should take judicial notice of the fact that it would not be expected that the recited crystallinity and cold crystallization temperature would be inherent in all such compositions.

Similarly, for the separate patentability of Claim 11, the Examiner makes substantially the same types of findings as for Claim 10, but for internal haze (Answer at 15), the reply thereto being the same as discussed above.

With regard to the argument of separate patentability of Claim 12, the Examiner finds "that since the structures have the same composition and heat shrinkage factor they also have the same relaxation stresses" (Answer at 15).

In reply, and again, in addition to the arguments discussed above, the Examiner has produced no facts suggesting any relationship between heat shrinkage factor and relaxation stresses.

The Examiner makes essentially the same finding for the separate patentability of Claim 13 (Answer at 15), the reply to which has been discussed above. Thus, the Examiner has produced no facts suggesting any relationship between heat shrinkage factor and the “no holes” limitation of this claim.

With regard to Applicants’ argument for separate patentability of Claim 14, the Examiner simply states that Applicants have “not precisely presented any analysis to support said conclusion” (Answer at 15-16).

In reply, the burden is on the Examiner to demonstrate that a rejected claim is unpatentable. It is the Examiner who must present analysis as to why the claim is unpatentable. The Examiner has not done so.

With regard to the argument for separate patentability of Claim 15, the Examiner finds that “as discussed above the acrylates are similar and it would have been obvious to substitute one for the other due to their similar functionality” (Answer at 16).

In reply, Applicants’ response does not address Applicants’ arguments.

With regard to the argument for separate patentability of Claim 21, again, the Examiner’s finding in the Answer that Applicants have “not presented any precise analysis or evidence to support said conclusion” (Answer at 16) does not respond to Applicants’ argument.

Finally, it bears repeating that there are significant differences, both in terms of structure and properties, between syndiotactic polystyrene, in which the direction of the pendant phenyl moiety alternates in a regular manner, and garden-variety polystyrene, also known as atactic polystyrene, in which the pendant phenyl moieties are arranged randomly.

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Reply Brief

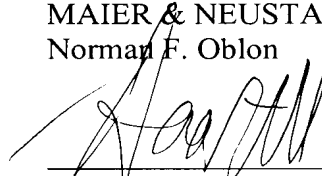
The Examiner either does not appreciate these distinctions or chooses to ignore them. Either way, it is clear error.

Applicants continue to maintain that the rejection should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Harris A. Pitlick', is written over a horizontal line.

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